

### **REMARKS/ARGUMENTS**

This Amendment is in response to the Office action of March 30, 2007. Claim 36 has been amended. Claims 1-35 have been canceled without prejudice and/or disclaimer. New claims 48-55 have been added. Claims 36-55 are pending in the application.

#### **Claim Rejections – 35 USC § 112**

On page 2 of the action, claims 37 and 38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Applicant respectfully traverses this rejection.

In particular, regarding claims 37 and 38, the action indicates that the examiner is unable to find support for the subject matter in the claims and that the examiner is able to find support for only one jaw having the increased traction but the examiner is unable to find support for the first and second pads having a first traction characteristic. Furthermore, the action further indicates that the examiner is also unable to find support for the first and second tissue contacting surfaces of the projections having a second traction characteristic that is different than the first traction characteristic of the first and second pads.

On page 3, lines 18-22, the specification describes that “the jaws 16 and 18 have opposing surfaces 22 and 24, respectively, which face each other. Since these surfaces 22, 24 will typically be formed of a hard plastic material, it is common to cover the surfaces 22 and 24 with a soft, compliant material or pad 26 and 28 having a tissue-contacting surface 30 and 32, respectively.” Referring now to page 6, lines 17-18, the specification describes that “the pads or inserts 26, 28 can also be molded to form multiple projections 55 arranged in a waffle pattern, such as that illustrated in Figures 13 and 14.” As such, the specification at least describes jaws 16 and 18 with respective pads 26 and 28 and each pad 26 and 28 having multiple projections 55.

Referring to page 6, lines 24-28, the specification describes that the “projections 55 can also be angled so that in a side view, such as that illustrated in

Figure 14, they have a saw-tooth shape. With this configuration, movement of tissue against the saw teeth would be opposed with a greater force than movement of tissue along the same teeth. In this manner, slippage can be inhibited by high traction in one direction and facilitated by low traction in the opposite direction." As such, using the above "saw-tooth shape example", the projections 55 on the pad 26 and pad 28 have a tissue contacting surface providing high traction in one direction (e.g., a second traction characteristic). Likewise, the surface of the pad 26 on the opposite direction or side, in which the projections face, provides a different first traction characteristic (e.g., a low traction).

Accordingly, in view of the above-remarks, reconsideration and withdrawal of the rejections to claims 37-38 are respectfully requested.

#### **Claim Rejection – 35 USC §102**

On page 3 of the action, Claims 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Klieman (U.S. Patent 5,171,253). Claim 1 has been canceled without prejudice and/or disclaimer.

Also, on page 3 of the action, Claims 36-40 and 42-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Fogarty (U.S. Patent 3,503,398). Applicant respectfully traverses this rejection. Claim 36 as amended recites opposable first and second pads formed of a soft resilient material, a multiplicity of first projections formed of the same soft resilient material as the first pad and disposed to extend outwardly of the first pad and to provide a first tissue contacting surface, and a multiplicity of second projections formed of the same soft resilient material as the second pad and disposed to extend outwardly of the second pad and to provide a second tissue contacting surface.

In the action, the action indicates that Fogarty discloses a device comprising opposable first and second pads formed from a resilient material, a multiplicity of first projections disposed to extend outwardly of the first pad and provide a first tissue

contacting surface, and a multiplicity of second projections disposed to extend outwardly of the second pad.

Fogarty, in col. 3, lines 5-7, does describe a "soft jaw insert 30 comprises a flexible rubber tube containing a closed chamber 31 filled with a suitable liquid such as glycerin." Conversely, Claim 36 provides a multiplicity of first projections formed of the same soft resilient material as the first pad and disposed to extend outwardly of the first pad.

Fogarty, in col. 3, lines 23-30, further describes an insertable hard jaw element comprises a tooth bar of metal or hard non-metallic material which may take different forms. A tri-directional tooth bar 50 is shown in FIGURES 4, 5 and 5A ... The face of the tooth bar has a center row of teeth 52 and two side rows of teeth 53." However, Claim 36 provides a first pad formed of a soft resilient material and a multiplicity of first projections formed of the same soft resilient material as the first pad and disposed to extend outwardly of the first pad.

As such, Fogarty at most describes a soft jaw insert without teeth or a hard jaw element with teeth and thus not a soft resilient material pad with soft resilient material projections extending outwardly of the pad as provided in Claim 36. Hence, Fogarty cannot anticipate claim 36. Accordingly, claim 36 is believed to be patentable. Since claims 37-46 depend from claim 36, and contain additional limitations that are patentably distinguishable over the references of record, claims 37-46 are also believed to be patentable. Reconsideration and withdrawal of the rejections are therefore respectfully requested.

### **Claim Rejections – 35 USC §103**

On page 6 of the action, Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fogarty. Applicant respectfully traverses this rejection.

Claim 47 recites "the radial cross-section of each of the first and second projections is oval." The action on page 6 indicates that Fogarty discloses the invention as claimed except for the radial cross-section of the first and second projections being ovular.

However, Fogarty describes in col. 3, lines 34-43, that the "center teeth 52 present relatively blunt surfaces in an upward direction 35 under direct clamping pressure but have points which are in a position to penetrate a clamped object when traction is applied to the object longitudinally of the jaws in a direction away from pivot 12. The side teeth 53 present relatively blunt surfaces in an upward direction under direct clamping pressure but have sharp points which are in a position to penetrate a clamped object when traction is applied in either direction transversely of the jaws."

An ovular projection would not provide such a sharp point as required by Fogarty and thus would make Fogarty inoperable as intended. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Accordingly, reconsideration and withdrawal of the rejection are therefore respectfully requested.

New **claims 48-55** describe other aspects of the invention. For example, new claim 48 provides that the first and second pads and the multiplicity of first and second projections comprise a hydrophilic material. New claim 49 provides that the multiplicity of first and second projections extend at an angle away from the proximal end of the respective first and second pad and away from the surface of the respective first and second pad and towards the distal end of the respective first and second pad and towards the surface of the respective first and second pad. New claim 50 provides that the multiplicity of first projections comprises at least three rows and three columns of projections with each projection identically angled and orientated on the first pad.

New independent claim 51 provides a first and second jaw having a respective first and second surface formed of a hard plastic material. A first and second soft compliant material pad covers the respective first and second surface of the respective first and second jaw and has a respective first and second tissue contacting surface. The second jaw is connected to the first jaw and is biased towards a proximal relationship with the first telescoping barrel portion. A plurality of first and second projections are integrated with the respective first and second soft compliant material pad and angle away from the respective first and second tissue contacting surface of the respective first and second soft compliant material pad.

New claim 52 depending from claim 51 provides that the first and second soft compliant material pads further comprises a hydrophilic material. New claim 53 depending from claim 52 provides that the first soft compliant material pad has a distal end and a proximal end adjacent to the connection between the first and second jaws and the plurality of first projections further comprises at least three rows and three columns of projections with each projection angled away from the first tissue contacting surface of the first soft compliant material pad and away from the proximal end of the first soft compliant material pad and towards the second tissue contacting surface of the second soft compliant material pad and towards the distal end of the first soft compliant material pad.

New claim 54 depending from claim 53 provides that each of the plurality of first projections has an axis extending between a first end and a second end, the first end being disposed in proximity to the first tissue contacting surface of the first soft resilient pad and each of the plurality of first projections has a radial cross-section that progressively decreases in area from the first end to the second end. New claim 55 depending from claim 54 provides that the radial cross-section throughout an entire length of each of the plurality of first projections is oval.

The cited references do not describe or suggest such an instrument with the recited features in new claims 48-55. Accordingly, in view of the above-amendments and remarks, claims 48-55 are believed to be patentable. Also, since claims 48-50 depend from independent claim 36 and thus incorporate the features

Application No.: 10/664,698  
Amdt dated: June 29, 2007  
Reply to Office action of March 30, 2007

recited in the claim and contain additional limitations that, when considered as a whole are patentably distinguishable over the references of record, claims 48-50 are believed to be patentable.

### **Conclusion**

In view of the foregoing remarks, it is respectfully submitted that this application is in condition for allowance. Accordingly, reconsideration of the application and allowance of claims 36-55 are respectfully requested. If the Examiner should have any remaining questions or objections, a telephone interview to discuss and resolve these issues is respectfully requested.

Respectfully Submitted,

APPLIED MEDICAL RESOURCES



Patrick Y. Ikehara  
Reg. No. 42,681  
Telephone: 949-713-8383